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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/591,912	06/09/2000	Douglas Coming	SCHW-410	3491

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EXAMINER

KARMIS, STEFANOS

ART UNIT PAPER NUMBER

3624

DATE MAILED: 12/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/591,912

Applicant(s)

CORNING ET AL.

Examiner

Stefano Karmis

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This communication is in response to Applicants' amendment filed on 15 September 2003.

Status of Claims

2. Claims 1-37 have been left as originally filed. Claim 38 has been added as a new claim. Therefore, claims 1-38 are under prosecution in this application.

Summary of this Office Action

3. Applicants' arguments filed on 15 September 2003 have been fully considered. New art has now been applied to the pending claims. Therefore claims 1-38 are rejected and Applicants' request for allowance is respectfully denied.

Response to Applicants' Amendment

4. Examiner acknowledges Applicants' arguments with respect to the 35 USC 102 rejection and 35 USC 103 rejection to Martyn et al., US Patent 6,195,647 and therefore withdraws the previous Office Action's rejections. Any remaining arguments are considered moot in view of the new grounds of rejections that has been established.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-4, 6-10 and 12-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Minton U.S. Patent 6,014,643.

Regarding independent claim 1 and 22, Minton discloses a computer implemented method for securities trading that comprises maintaining a data list which includes all of the plurality of items being tracked (column 10, lines 15-27); including in the data list a category tag for each of the plurality of items being tracked (column 10, lines 28-42 and Figure 5); and displaying in a sublist associated with a designated category tag all of those items in the data list which have the designated category tag (column 10, lines 28-42 and Figure 5 and column 15, lines 14-24).

Regarding independent claims 14 and 30, Minton discloses a method that tracks securities that comprises a computing device in which information related to each of the plurality of the items being tracked is maintained in a data list, wherein the related information for each of the plurality of items includes a classification tag (column 10, lines 15-27 and Figure 5); a central communications center which is capable of exchanging with the computing device the

related information of the items being tracked (column 7, lines 32-60); wherein the computing device is capable of displaying a list of all of the plurality of items tracked by identifier and the associated classification tag, and is capable of displaying sublists of the plurality of the items being tracked organized by classification tag along with information about the items in the displayed sublists (column 10, lines 28-42 and Figure 5 and column 15, lines 14-24).

Claims 2, 6-8, 18-21, 26-29 and 34-37, the number of items being tracked is limited to a certain number or the maximum selected (column 10, lines 28-42); displaying a running total of the items in the data list or the maximum selected (Figure 5).

Claim 3, 17, 25, and 33, wherein securities are included among the plurality of items being tracked (column 10, lines 15-27).

Claim 4, 15, 23 and 31, wherein the computing device is a personal organizer device (column 4, lines 30-35).

Claim 9-10, Minton discloses of adding new items to the plurality of items being tracked by way of entering an identifier for each item and a category tag is supplied for each item (column 10, lines 28-42 and Figure 5).

Claims 12-13, the displaying step includes the step of including selected information about the items being displayed in the sublist which information includes information received

from the communications center and displaying the data list (column 10, lines 28-42 and Figure 5 and column 7, lines 32-60).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 5, 11 and 38 rejected under 35 U.S.C. 103(a) as being unpatentable over Minton U.S. Patent 6,014,643 in view of Bushner (hereinafter Bushner) et al. U.S. Patent 6,462,671.

Regarding independent claim 38 and claim 5, Minton teaches a computer implemented method for securities trading that comprises maintaining a data list which includes all of the plurality of items being tracked (column 10, lines 15-27); including in the data list a plurality of category tags for each of the plurality of items being tracked (column 10, lines 28-42 and Figure 5); a central communications center which is capable of exchanging with the computing device the related information of the items being tracked (column 7, lines 32-60); and displaying in a sublist associated with a designated category tag all of those items in the data list which have the designated category tag (column 10, lines 28-42 and Figure 5 and column 15, lines 14-24).

Minton fails to teach providing the information and implementing the process on a hand held device. Bushner teaches a remote securities based data reception and order system in which a hand held device is used to send and store security information including displaying quote information and any pertinent data relating to the security (column 7, lines 35-47). It would be obvious to one of ordinary skill in the art, that the teachings of Minton could be modified to include the teachings of Bushner and allow for the tracking method to be performed with the use of a hand held device. There is sufficient motivation to combine references because both systems utilize computer technology to monitor and send security information to central computers in an effort to trade desired securities and provide users with all pertinent information needed for trading of the security.

Claim 11, Minton teaches the number of items being tracked is limited to a certain number based on what is available for trade (column 10, lines 28-42). Minton fails to teach that user must delete at least a selected one of the plurality of items being tracked whenever the

number of items being tracked will exceed a predetermined limit number because of the addition of the new item. Official Notice is taken that adding and deleting from a list is old and well known in the computer arts. Therefore it would have been obvious at the time of the Applicants' invention to require the deletion of an item if new items are to be added to a list that is already at a predetermined limit because it allows for the newly desired item to be viewed by the user and space is required in the list, which can only be provided by eliminating items already in the list.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefano Karmis whose telephone number is (703) 305-8130. The examiner can normally be reached on M-F: 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-1113.

Respectfully Submitted
Stefano Karmis
December 5, 2003



**VINCENT MILLIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600**